

REMARKS:

Claims 1-34 are currently pending in the application.

Claims 1-34 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,038,668 to Chipman *et al.* ("*Chipman*") in view of U.S. Patent No. 6,094,680 to Hokanson ("*Hokanson*") and in further view of U.S. Patent No. 6,081,840 to Zhao ("*Zhao*").

Although the Applicant believes Claims 1-34 are directed to patentable subject matter without amendment, the Applicant has amended Claim 33 to correct a typographical error. By making this amendment, the Applicant makes no admission concerning the merits of the Examiner's rejection, and respectfully reserves the right to address any statement or averment of the Examiner not specifically addressed in this response. Particularly, the Applicant expressly reserves the right to pursue broader claims in this Application or through a continuation patent application. No new matter has been added.

REJECTION UNDER 35 U.S.C. § 103(a):

Claims 1-34 stand rejected under 35 U.S.C. § 103(a) over *Chipman* in view of *Hokanson* and in further view of *Zhao*.

Although the Applicant believes Claims 1-34 are directed to patentable subject matter without amendment, the Applicant has amended Claim 33 to correct a typographical error. By making this amendment, the Applicant does not indicate agreement with or acquiescence to the Examiner's position with respect to the rejections of these claims under 35 U.S.C. § 103(a), as set forth in the Office Action.

The Applicant respectfully submits that *Chipman*, *Hokanson*, or *Zhao*, either individually or in combination, fails to disclose, teach, or suggest each and every element of Claims 1-34. Thus, the Applicant respectfully traverses the Examiner's obvious rejection of Claims 1-34 under 35 U.S.C. § 103(a) over the proposed combination of *Chipman*, *Hokanson*, and *Zhao*, either individually or in combination.

The Proposed *Chipman-Hokanson-Zhao* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicant's Claims

For example, with respect to independent Claim 1, this claim recites:

A method for migrating product data within an electronic commerce system, comprising:

monitoring requests for product data by users of ***a global content directory***, the global content directory comprising:

a directory structure comprising a plurality of ***product classes*** organized in a hierarchy, each product class ***categorizing a plurality of products and defining one or more attributes of the products categorized in the product class***; and

one or more pointers associated with each product class, each pointer ***identifying a seller database*** in which product data enabling a product transaction is stored for products associated with the product class;

generating a request history for each of the users ***based on the monitoring of the requests for product data by the users***;

identifying the location of a particular user,

determining, based at least in part on the request history for the particular user and a relative size of an organization associated with the particular user, ***whether the product data*** requested by the particular user ***should be migrated from a seller database to a storage location that is closer to the identified location of the particular user*** than the seller database; and

if it is determined that ***the product data should be migrated, initiating the migration of the product data*** requested by the particular user from the seller database to the storage location, determined for the particular user, that is closer to the identified location of the particular user than the seller database. (Emphasis Added).

Independent Claims 17, 33, and 34 recite similar limitations. *Chipman*, *Hokanson*, or *Zhao* fails to disclose each and every limitation of independent Claims 1, 17, 33, and 34.

The Applicant respectfully submits that *Chipman* has nothing to do with independent Claim 1 limitations regarding a method or software ***“for migrating product data within an electronic commerce system”*** and in particular *Chipman* has nothing to do with independent Claim 1 limitations regarding “monitoring requests for product data by users of ***a global content directory***”. In particular, it appears that the Examiner is equating the ***“global content directory”*** recited in independent Claim 1 with the ***“portal”***

disclosed in *Chipman*. (24 May 2006 Office Action, Pages 7-8). However, the “**portal**” disclosed in *Chipman* merely provides “an entry way into the stored catalogs of information”, **and does not include or is not even related to the global content directory**, as recited in independent Claim 1. (Column 5, Lines 5-10). In contrast, the “**global content directory**” recited in independent Claim 1 is provided for “monitoring requests for product data by users”. Thus, the Applicant respectfully submits that the equations forming the foundation of the Examiner’s comparison between *Chipman* and independent Claim 1 cannot be made. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish independent Claim 1 from *Chipman*.

The Applicant respectfully submits that *Chipman* has nothing to do with independent Claim 1 limitations regarding the “**global content directory**” comprising “**a directory structure** comprising a plurality of **product classes** organized in a hierarchy, each product class **categorizing a plurality of products and defining one or more attributes of the products categorized in the product class**” and “**one or more pointers associated with each product class**, each pointer **identifying a seller database** in which product data enabling a product transaction is stored for products associated with the product class”. In particular, it appears that the Examiner is equating the “**one or more pointers**” recited in independent Claim 1 with the “**data agents**” disclosed in *Chipman*. (24 May 2006 Office Action, Page 8). However, the “**data agents**” disclosed in *Chipman* merely provide for a process in which a supplier may gather information from users in order to enhance the usability of the supplier’s site, **and does not include or is not even related to the one or more pointers associated with each product class**, as recited in independent Claim 1. (Column 9, Line 63 through Column 10, Line 9). In contrast, the “**one or more pointers**” recited in independent Claim 1 is “**associated with each product class**” wherein “each pointer **identifying a seller database** in which product data enabling a product transaction is stored for products associated with the product class”. Thus, the Applicant respectfully submits that the equations forming the foundation of the Examiner’s comparison between *Chipman* and independent Claim 1 cannot be made. The Applicant further respectfully submits that

these distinctions alone are sufficient to patentably distinguish independent Claim 1 from *Chipman*.

The Office Action Acknowledges that *Chipman* Fails to Disclose Various Limitations Recited in Applicant's Claims

The Applicant respectfully submits that the Office Action acknowledges, and the Applicant agrees, that *Chipman* fails to disclose the emphasized limitations noted above in independent Claim 1. Specifically the Examiner acknowledges that *Chipman* fails to disclose “**generating a request history** for each of the users **based on the monitoring of the requests for product data by the users**” and “**identifying the location of a particular user**”. (24 May 2006 Office Action, Pages 9-10). However, the Examiner asserts that the cited portions of *Hokanson* and *Zhao* disclose the acknowledged shortcomings in *Chipman*. The Applicant respectfully traverses the Examiner's assertions regarding the subject matter disclosed in *Hokanson* and *Zhao*.

The Applicant further respectfully submits that *Hokanson* has nothing to do with independent Claim 1 limitations regarding a method or software “**for migrating product data within an electronic commerce system**” and in particular *Hokanson* has nothing to do with independent Claim 1 limitations regarding “**identifying the location of a particular user**”. It appears that the Examiner is equating “**identifying the location**” recited in independent Claim 1 with the “**processor**” disclosed in *Hokanson*. (24 May 2006 Office Action, Page 9). However, the “**processor**” disclosed in *Hokanson* merely “monitors users requests for different resources” wherein the users request may be available locally or remotely, **and does not include or is not even related to the “identifying the location of a particular user”**, as recited in independent Claim 1. (Column 6, Line 62 through Column 7, Line 7). In contrast, “**identifying the location**” recited in independent Claim 1 is provided for “**identifying the location of a particular user**”. Thus, the Applicant respectfully submits that the equations forming the foundation of the Examiner's comparison between *Chipman* and *Hokanson* and independent Claim 1 cannot be made. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish independent Claim 1 from *Chipman* and *Hokanson*.

The Applicant still further respectfully submits that *Hokanson* or *Zhao* have nothing to do with independent Claim 1 limitations regarding a method or software “**for migrating product data within an electronic commerce system**” and in particular *Hokanson* or *Zhao* have nothing to do with independent Claim 1 limitations regarding “**generating a request history** for each of the users **based on the monitoring of the requests for product data by the users**”. It appears that the Examiner is equating the “**monitoring of the requests**” recited in independent Claim 1 with “monitor[ing] the usage requests” disclosed in *Zhao*. (24 May 2006 Office Action, Pages 9-10). However, “monitor[ing] the usage requests” disclosed in *Zhao* merely provide for a process in which a local server monitors usage requests from local users to find if some files are frequently requested then the local server requests the file for storage in the local server, **but does not include or is not even related to the monitoring of the requests**, as recited in independent Claim 1. (Column 4, Lines 45-60). In contrast, “**monitoring of the requests**” recited in independent Claim 1 is provided for “**generating a request history** for each of the users” and is “**based on the monitoring of the requests**” which is “**for product data by the users**”. Thus, the Applicant respectfully submits that the equations forming the foundation of the Examiner’s comparison between *Chipman*, *Hokanson*, and *Zhao* and independent Claim 1 cannot be made. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish independent Claim 1 from *Chipman*, *Hokanson*, and *Zhao*.

The Office Action Still Further Acknowledges that *Chipman* Fails to Disclose Various Limitations Recited in Applicant’s Claims

The Applicant respectfully submits that the Office Action acknowledges, and the Applicant agrees, that *Chipman* fails to disclose the emphasized limitations noted above in independent Claim 1. Specifically the Examiner acknowledges that *Chipman* fails to disclose “**determining**, based at least in part on the request history for the particular user and a relative size of an organization associated with the particular user, **whether the product data** requested by the particular user **should be migrated from a seller database to a storage location that is closer to the identified location of the particular user** than the seller database” and “**if** it is determined that **the product data**

should be migrated, initiating the migration of the product data requested by the particular user from the seller database to the storage location, determined for the particular user, that is closer to the identified location of the particular user than the seller database.” (24 May 2006 Office Action, Page 8). However, the Examiner asserts that the cited portions of *Hokanson* disclose the acknowledged shortcomings in *Chipman*. The Applicant respectfully traverses the Examiner’s assertions regarding the subject matter disclosed in *Hokanson*.

The Applicant further respectfully submits that *Hokanson* has nothing to do with independent Claim 1 limitations regarding a method or software “***for migrating product data within an electronic commerce system***” and in particular *Hokanson* has nothing to do with independent Claim 1 limitations regarding “***determining***, based at least in part on the request history for the particular user and a relative size of an organization associated with the particular user, ***whether the product data*** requested by the particular user ***should be migrated from a seller database to a storage location that is closer to the identified location of the particular user*** than the seller database”. It appears that the Examiner is equating ***determining whether the product data should be migrated*** recited in independent Claim 1 with the “***storage facility***” disclosed in *Hokanson*. (24 May 2006 Office Action, Pages 8-9). However, the “***storage facility***” disclosed in *Hokanson* merely provides resources to users of the network, ***and does not include or is not even related to determining whether the product data should be migrated***, as recited in independent Claim 1. (Column 2, Lines 35-61). In contrast, ***determining whether the product data should be migrated*** recited in independent Claim 1 is based “at least in part on the request history for the particular user and the relative size of an organization associated with the particular user”. In addition, the determination is made whether to migrate the product data “***from a seller database to a storage location that is closer to the identified location of the particular user*** than the seller database”. Thus, the Applicant respectfully submits that the equations forming the foundation of the Examiner’s comparison between *Hokanson* and independent Claim 1 cannot be made. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish independent Claim 1 from *Hokanson*.

The Office Action has Failed to Properly Establish a *Prima Facie* case of Obvious over the Proposed *Chipman-Hokanson-Zhao* Combination

The Applicant respectfully submits that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of *Chipman*, *Hokanson*, or *Zhao*, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine these references as proposed. The Office Action merely states that “it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of *Chipman* and include the ability to migrate product data from sellers databases to storage locations closer to the user that requested the information as taught by *Hokanson*”. (24 May 2006 Office Action, Page 9). (Emphasis Added). The Applicant respectfully disagrees. The Office Action merely further states that “it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of *Chipman* and include generating request histories for each user based on the teachings of *Hokanson* and *Zhao*”. (24 May 2006 Office Action, Page 10). (Emphasis Added). The Applicant respectfully disagrees.

The Applicant further respectfully submits that this purported advantage relied on by the Examiner is nowhere disclosed, taught, or suggested in *Chipman*, *Hokanson*, or *Zhao*, either individually or in combination. The Examiner asserts that the motivation to combine the references as proposed would be to “**facilitate quick access to the variety of information stored locally**”. (24 May 2006 Office Action, Page 9). (Emphasis Added). The Applicant respectfully disagrees and further respectfully requests clarification as to how the Examiner arrives at this conclusion. For example, how does the ability to “**facilitate quick access to the variety of information stored locally**” directly determine “**whether the product data** requested by the particular user **should be migrated from a seller database to a storage location that is closer to the identified location of the particular user** than the seller database” and to what extent does the Examiner purport that to “**facilitate quick access to the variety of information stored locally**” applies to the subject Application. The Examiner further asserts that the motivation to combine the

references as proposed would be to ***“enable the local servers to handle most file requests without the need to contact the source server and reduce the communications overhead resulting in such contacts.”*** (24 May 2006 Office Action, Page 10). (Emphasis Added). The Applicant respectfully disagrees and further respectfully requests clarification as to how the Examiner arrives at this conclusion. For example, how does ***“enable[ing] the local servers to handle most file requests without the need to contact the source server”*** directly ***“reduce the communications overhead resulting in such contacts”*** and to what extent does the Examiner purport that ***“reduce[ing] the communications overhead”*** applies to the subject Application. ***The Applicant respectfully requests the Examiner to point to the portions of Chipman, Hokanson, or Zhao which contain the teaching, suggestion, or motivation to combine these references for the Examiner’s stated purported advantage.*** The Applicant further respectfully submits that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the ***prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art.*** *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. With respect to the subject Application, the ***Examiner has not adequately supported the selection and combination of Chipman, Hokanson, or Zhao to render obvious the Applicant’s claimed invention.*** The Examiner’s above-referenced conclusory statements ***do not adequately address the issue of motivation to combine.*** This factual question of motivation is material to patentability, and cannot be resolved on subjective belief and unknown authority. *Id.* It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to “[use] that which the inventor taught against its teacher.” *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Thus, ***the Office Action fails to provide proper motivation for combining the teachings of Chipman, Hokanson, or Zhao***, either individually or in combination.

The Applicant's Claims are Patentable over the Proposed *Chipman-Hokanson-Zhao* Combination

The Applicant respectfully submits that independent Claim 1 is considered patentably distinguishable over the proposed combination of *Chipman*, *Hokanson*, and *Zhao*. This being the case, independent Claims 17, 33, and 34 are also considered patentably distinguishable over the proposed combination of *Chipman*, *Hokanson*, and *Zhao*.

With respect to dependent Claims 2-16 and 18-32; Claims 2-16 depend from independent Claim 1 and Claims 18-32 depend from independent Claim 17. As mentioned above, each of independent Claims 1, 17, 33, and 34 are considered patentably distinguishable over *Chipman*, *Hokanson*, and *Zhao*. Thus, dependent Claims 2-16 and 18-32 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For at least the reasons set forth herein, the Applicant respectfully submits that Claims 1-34 are not rendered obvious by the proposed combination of *Chipman*, *Hokanson*, and *Zhao*. The Applicant further respectfully submits that Claims 1-34 are in condition for allowance. Thus, the Applicant respectfully request that the rejection of Claims 1-34 under 35 U.S.C. § 103(a) be reconsidered and that Claims 1-34 be allowed.

THE LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, ***there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.*** Second, there must be a reasonable expectation of success. Finally, ***the prior art reference*** (or references when combined) ***must teach or suggest all the claim limitations.*** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, ***and not based on applicant's disclosure.*** *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim

limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, ***there must be something in the prior art as a whole to suggest the desirability***, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

CONCLUSION:


In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

Although the Applicant believes no fees are deemed to be necessary; the undersigned hereby authorizes the Commissioner to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

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Date


James E. Walton, Registration No. 47,245
Steven J. Laureanti, Registration No. 50,274
Daren C. Davis, Registration No. 38,425
Michael Alford, Registration No. 48,707
Law Offices of James E. Walton, P.L.L.C.
1169 N. Burleson Blvd., Suite 107-328
Burleson, Texas 76028
(817) 447-9955 (voice)
(817) 447-9954 (facsimile)
steven@waltonpllc.com (e-mail)

CUSTOMER NO. 53184

ATTORNEYS AND AGENTS FOR APPLICANT